

No. 2462

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IN THE  
**United States Circuit Court of Appeals**  
FOR THE NINTH CIRCUIT.

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**L. A. PEDERSEN,**  
*Defendant-Appellant,*  
*vs.*  
**PATRICK F. DUNDON,**  
*Plaintiff-Appellee.*

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**Brief for Defendant-Appellant.**

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WILLIAM K. WHITE,  
For Defendant-Appellant.

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THE JAMES H. BARRY CO.

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PATRICK F. DUNDON,  
*Defendant-Appellant,*  
*Plaintiff-Appellee.*

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**BRIEF ON BEHALF OF DEFENDANT-APPELLANT.**

This case comes before this Court on an appeal from the interlocutory decree of the United States District Court for the Northern District of California.

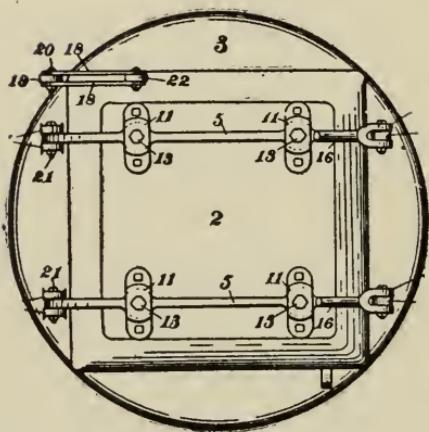
In and by said decree claim 3 of United States letters patent No. 653,503 issued on July 10, 1900, to Patrick Dundon for "Door for Digesters" is adjudged valid and infringed.

The parties stipulated that this appeal be heard upon the agreed statement of the case found on page 4 of the record.

The case presents two important questions for determination, to wit:

- I. Can a functional limitation in a claim be ignored?

DUNDON'S DEVICE



2. Is a plaintiff entitled to a recovery of *both* damages and profits?

On the opposite page appears a reproduction of figure 1 of the Dundon patent disclosing a front elevation of the patented door and the frame upon which it is mounted. Regarding his invention, Mr. Dundon, in his patent, says:

“My invention relates to doors for hermetically sealing retorts, digesters or other vessels that sustain internal pressure and to certain improvements in devices for *hinging*, closing, and securely sealing such doors . . . .

“My present improvements consist in two or more bars that span the doors, bearing usually at four points thereon, so selected as to equalize the pressure around the sealed joints and utilize the full strength of the door itself in resisting the compressing strain: also, *consists in the manner of hinging the doors by means of the bearing bars* and a compensating link pivoted coincident therewith, and in other structural devices that will be particularly pointed out and explained by the aid of the drawings herewith and forming a part of this specification.

“*The main objects of my invention are celerity of action in opening and closing such doors, security against leaks, and to utilize the bearing-bars as hinges on which the door may swing and thus dispense with independent pivoting devices, avoiding the cost and complication of the latter.*

“In sealing doors of the class here illustrated, especially for retorts that are frequently opened and closed, as in treating food, *it is an object to quickly open and close the doors, also to produce*

*a close joint without the use of numerous independent clamping screws."*

It will be noted that the patentee expressly states that the *main objects* of his invention are "*celerity of action in opening and closing such doors . . . and to utilize the bearing-bars as hinges on which the door may swing and thus dispense with independent pivoting devices, avoiding the cost and complication of the latter.*"

By referring to said Fig. I, it will be seen that the door 2 is mounted on the pressing-bars 5 curved at the ends 6 to fit between the lugs 7 on the door-frame 3. These pressing-bars, therefore, form the hinges for the door and on them the door is supported and swung when being opened and closed. The radius links 18 form an additional hinge and support for the door and they are pivoted on the same axial line as the pressing-bars 5 and *hold the door in adjustment on such bars.* In Fig. II of the Dundon patent is shown a top view of the door and other devices mentioned.

Having emphasized the objects of his invention and having, in the drawings and specification of the patent, clearly disclosed the means for attaining said objects, the patentee claims said means as follows:

"3. In a hermetically-closing door, pressing bars to force the door upon its seat, bearing at four or more points thereon, *forming also hinges for the door, and in combination therewith the radius-links 18 pivoted in the same axial line as the press-*

*ing bars and holding the door in adjustment thereon, substantially as specified.”*

The law presumes all of the elements of said claim to be old. The invention covered by the claim necessarily resides in the new combination of such old elements.

“The point to be emphasized is that the law looks not at the elements or factors of an invented combination as a subject for a patent, but only to the combination itself as a unit distinct from its parts.”

*Yesbera v. Hardesty Co.*, 166 Fed., 125.

Therefore, the combination of claim 3 must be considered as a “unit distinct from its parts.” In comparing such “unit” with another combination to determine the question of identity between them, no single element of such “unit” and no functional limitation, respecting any such element, can be ignored. In the lower court, it was necessary for opposing counsel, in arguing the question of infringement, to contend that the functional limitations of claim 3 should be ignored because said functional limitations differentiated the defendant’s device from that of plaintiff. To clearly show the limitations of claim 3 which differentiate defendant’s device therefrom, we shall now set forth said claim with such limitations enclosed in brackets. If such limitations are not ignored it is ad-

mitted by opposing counsel that there is no infringement.

"3. In a hermetically-closing door, pressing-bars to force the door upon its seat, bearing at four or more points thereon, (*forming also hinges for the door,*) and in combination therewith the radius-link(s) 18 pivoted (*in the same axial line as the pressing-bars and holding the door in adjustment thereon*), substantially as specified."

The first limitation is expressed in the words "*forming also hinges for the door.*" This is a functional limitation and limits the combination to one in which the pressing-bars not only perform the function of pressing-bars *but also perform the additional function of hinges for the door.* There are a number of decisions to the effect that a *functional limitation* can not be ignored or, in other words, be treated as merely pointing out the preferable form of embodiment and we know of no decisions in direct conflict therewith.

In *Thomson Meter Co. v. National Meter Co.*, 106 Fed., 530, it is said by Judge Townsend:

" . . . As a matter of law it is settled that such a specific statement of function thus inserted in a claim as material cannot be disregarded."

In this case, there can be no question as to the intention of Dundon to make material the feature of the pressing-bars performing the additional function of hinges. In the specification of the patent, he expressly states: "My present improvements . . .

also, consists in the manner of hinging the doors by means of the bearing-bars, . . . ?"

"The main objects of my invention are celerity of action in opening and closing such doors . . . and to utilize the bearing-bars as hinges on which the door may swing and thus dispense with independent pivoting devices avoiding the cost and complication of the latter."

Having so expressly and emphatically stated in his patent that his invention, in part, consists in so utilizing the pressing-bars as hinges and that one of the main objects of his invention was to so utilize them, we respectfully submit that the patentee-plaintiff is estopped from contending that such utilization of the pressing-bars as hinges is not material and that the words of claim 3, expressly limiting the combination to one in which the pressing-bars are so utilized as hinges, should be treated merely as words of description pointing out the preferable form of embodiment.

On this point, the words of the Circuit Court of Appeals for the Eighth Circuit in the case of *O. H. Jewell Filter Co. v. Jackson*, 140 Fed., 347, are pertinent:

"The truth is that the patentees and the appellant, their successor in interest, are estopped by the declarations in the patent which have been cited, from claiming a monopoly of any invention which does not include the specific form of lateral arm which they described. The statute requires the inventor to point out and distinctly claim his inven-

tion. When he has done this, he has thereby disclaimed and dedicated to the public all other combinations and improvements apparent from his specifications and claims that are not evasions of the improvement he points out. The patent is a notice to all the world, not only of the improvements claimed, but of those that are dedicated to the public, and the patentee is justly estopped from subsequently claiming the latter. Here the patentees by their specification entered a distinct disclaimer of a combination of the straight lateral arm, with the other elements specified in their claim, and made a clear statement that their invention consisted of two series of finger bars movable in different planes. It was too late for them to recall and modify these statements after the defendant, in reliance upon them, had constructed and put in operation a combination with other elements of an arm which does not and cannot have the two series of finger bars moving in different planes."

Mr. Dundon, having expressly declared that his improvements, in part, consist in the manner of hinging the doors by means of the bearing bars and that one of the main objects of his invention was to so utilize them, it was too late for him to recall and modify such statements after the defendant, in reliance upon them, had constructed and put into use a combination in which the pressing-bars did not perform the function of hinges.

In the case of *Swain v. Holyoke Co.*, 111 Fed., 411, Judge Putnam said:

"To ignore the express functional limitation of

the claim, viz., 'arms adapted to engage with the sides of the hole,' would be to create a new claim, not interpret the one granted. *Anthony Co. v. Genert*, 108 Fed., 396."

In the Anthony case, mentioned by Judge Putnam, it is said by the Court of Appeals for the Third Circuit:

"To ignore the express functional limitations of the claim, viz.: 'whereby they are enabled to fold back into the case side by side,' would be to create a new claim; not interpret the one granted. The court below rightly held there was no infringement."

In the *Thomson Meter Co. case, supra*, it is also said by Judge Townsend:

"In *Computing Scale Co. v. Keystone Store-Service Co.* (C. C.), 88 Fed., 788, the claim was for a certain combination 'whereby the pivotal supports of the beam and rod, e, may be brought into alignment, as and for the purpose described.' The Court held that this covered only such a combination so constructed that the supports might be brought into alignment as and for the purpose described and said:

"'The insertion of these words meant something, and they must be given due weight. The construction we adopt accords them meaning. That of complainant ignores their presence, and makes non-essential what the patentee and the office have deemed material and essential.'

"In *Renwick v. Pond*, 20 Fed. Cas., 536, Judge Blatchford said that where a combination was claimed, so arranged as to effect a certain engage-

ment, 'if the combination exists, yet, if it is not so arranged as to effect such engagement, there is no infringement.' See, also, *Lovell v. Johnson*, 33 C. C. A., 426, 91 Fed., 160; *J. L. Owens Co. v. Bradley* (C. C.), 83 Fed., 482; *Roemer v. Peddie*, 26 C. C. A., 440, 81 Fed., 380; *Whitaker Cement Co. v. Huntington Dry Pulverizer Co.*, 37 C. C. A., 151, 95 Fed., 471.

In view of the foregoing authorities and the obvious fact that, in his patent, Dundon emphatically made the feature of the pressing-bars forming hinges a material feature and not merely a preferable form of embodiment, we respectfully submit that a device, in which the pressing-bars do not operate as hinges, is not an infringement. If said functional limitation be ignored and the claim construed as covering such a device, then the claim will cover a device which cannot, according to the patentee himself, attain one of the "*main objects of the invention.*" Such being true, how can it successfully be contended that such a device is substantially identical with said invention? Defendant's structure is such a device. In it, the pressing-bars do not operate as hinges; they are entirely disconnected at both ends from the walls of the retort before the door is swung open upon its hinges, which operate independently of the pressing-bars. These facts are not disputed and are apparent from an inspection of the cut of the defendant's device appearing on page 5 of the record.

In the case of *Kings County Raisin & Fruit Co. v.*

*United States Consolidated Seeded Raisin Co.*, 182 Fed., 59, this Court, speaking through Judge Gilbert, said:

“It does not necessarily follow, from the fact that the claim describes a specific form of construction, that the inventor shall be limited to that form. All depends on his *expressed intention*, and the scope of the actual invention which he has made. If his improvement is but a narrow one, *or if he has used language such as clearly to show his intention to limit his invention to a particular form described*, then he is held to the language of his claim, and limited to that specific form. But if his is a pioneer invention, or one of such merit as to be entitled to a liberal construction, the claim will not be thus limited, even if couched in specific language, *unless the inventor has also shown his positive intention to relinquish to the public all other forms in which his invention might be embodied.*”

It is to be noted that, in the above case, the question of “functional limitations” in a claim was not involved. According to the authorities cited by us, limitations of that particular character are not viewed in the same way as ordinary limitations, which are generally treated as mere *words of description* pointing out the preferable form of embodiment.

However, the Kings County Co. decision is directly in point in regard to our contention that the language used in the Dundon specification is “*such as clearly to show his intention to limit his invention to a particular form described*” in said specification. He expressly states that one of the *main objects of his invention* is

the utilization of the pressing-bars as hinges for the door. He also expressly states that one of the *main objects of his invention* is "*celerity of action in opening and closing such doors.*" Such celerity of action is due to such utilization of the pressing-bars as hinges. By referring to the cut of defendant's device, it will be seen that, in order to open the door therein, it is first necessary to unscrew the nuts at each end of the pressing-bar. Each of these nuts is provided with a handle and there are four such nuts to be so manipulated and four screws to be thrown back out of engagement with the respective pressing-bars, before the door can be swung open on its hinges. In the Dundon device, by reason of the pressing-bars operating as hinges, it is only necessary to manipulate the holding means at one end of each pressing-bar in order to open the door. Dundon, therefore, attains one of the *main objects of his invention*, to wit: "*celerity of action in opening and closing*" the door, by using the pressing-bars as hinges, thereby cutting in half the work required to be done in opening the defendant's door. As Dundon also says: "*In sealing-doors of the class here illustrated, especially for retorts that are frequently opened and closed, as in treating food, it is an object to quickly open and close the doors . . .*"

In view of said statements of the patentee, we respectfully submit that he has clearly shown his intention to limit his invention to the particular form shown in the patent drawings and his said intention is also

evidenced by the wording of claim 3, which is expressly limited to a combination in which the pressing-bars form hinges for the door.

The next limitation of claim 3 restricts the combination to one in which more than one link or tie rod is used to keep the door in adjustment on the pressing-bars and keep it from sagging. It will be noted that the word "links" is in the plural, thus calling for at least two links or tie-rods. It is not contended that there is more than one link or tie-rod in defendant's device to keep the door from sagging. It is obvious, therefore, that defendant has dispensed with one of the elements of claim 3 and has substituted nothing in its place. For this reason, it may be contended that defendant's device does not infringe.

"Nothing in the law of patents is better settled than the rule that a claim for a combination is not infringed if any one of the described or specified elements is omitted, without the substitution of anything equivalent thereto."

*American School Furniture Co. v. Sander Co.,*  
113 Fed., 577.

The next limitation of claim 3 is expressed in the words:

" . . . pivoted in the same axial line as the pressing-bars and holding the door in adjustment thereon."

According to this limitation, the links 18 must both

be pivoted in the same axial line in which the pressing-bars are pivoted. By referring to the cut of defendant's device, it will be seen that the pressing bars are not pivoted at all and are not connected to the retort wall in the same axial line in which the single tie-rod is pivoted. It will also be noted that the words "*holding the door in adjustment thereon*" are a functional limitation and restrict the combination to one in which two or more links or tie-rods *hold the door in adjustment on the pressing bars*. In defendant's device, the door is not supported by the pressing-bars but, on the contrary, the door supports the pressing-bars. Therefore, the single tie-rod used by defendant cannot hold the door in adjustment on the pressing-bars which are supported by the door. Such tie-rod or link merely prevents the door from sagging upon its hinges, thus keeping it in adjustment relative to the hinges and *not* relative to the pressing-bars. In fact, such tie-rod is merely a third hinge in defendant's structure.

The use of such a tie-rod is shown in the Unfried patent to be found at page 34 of the record. The tie-rod in this Unfried structure performs the same function as the tie-rod in defendant's structure. In the Unfried patent, it is said on page 1, line 90:

"The said tie-rod E obviously serves to hold the free end of the gate from sinking or sagging . . ."

If claim 3 is construed as broadly covering a link or tie-rod for keeping any kind of a closure for an

opening in adjustment upon its hinges, then we insist said claim is anticipated by the Unfried patent. However, in our opinion, such a broad construction of the claim would be improper and inconsistent with the *expressed intention* of the patentee to limit it to the form shown in the drawings and described in the specification. Furthermore, we submit that the patentee is estopped from contending for any such broad construction.

In view of the fact that the single link or tie-rod in defendant's device does not hold the door in adjustment on the pressing-bars, said device, under the quoted authorities, cannot infringe claim 3 because of such functional limitation expressed in said words "*pivoted in the same axial line as the pressing-bars and holding the door in adjustment thereon.*"

A comparison of Fig. 1 of the Dundon patent with the cut of defendant's device discloses the differences between the two and, according to the expressed limitations of claim 3 and according to the statements of the patentee in his specification, his invention, in part, resides in such differences. Ignore such limitations and the Dundon invention, *as expressly defined by himself*, disappears.

Claim 3 is limited to a door having pressing-bars operating as hinges. The defendant's pressing-bars do not operate as hinges. Claim 3 is limited to a door prevented from sagging by two or more links or tie-rods. The defendant's device has but one link or

tie-rod. Claim 3 is limited to a door in which two or more links or tie-rods are pivoted in the same axial line in which the pressing bars are pivoted. The defendant's pressing-bars are not pivoted at all, because they do not operate as hinges. Claim 3 is limited to a door held in adjustment *on the pressing-bars* by two or more links or tie-rods. In the defendant's device, the door is supported by hinges and is not held in adjustment on the pressing-bars, which in fact are supported by the door instead of supporting the door as in the device of claim 3.

In view of the foregoing, we respectfully submit that the limitations of claim 3 should not be ignored and that the patentee-plaintiff is estopped from contending his invention does not, in part, reside in such limitations. If said limitations are not treated as mere words of description, contrary to the expressed statements of the patentee, there is no infringement.

#### DAMAGES AND PROFITS NOT BOTH RECOVERABLE.

The interlocutory decree contains the following paragraph:

“And it is further ordered, adjudged and decreed, that the complainant do recover of the defendant the profits, gains and advantages which the said defendant has received or made, or which have arisen or accrued to him by the manufacture, use or sale of Doors for Digesters, in violation of claim 3 of said letters patent, and that the complainant do recover the damages resulting from said infringement.”

Our contention is that plaintiff is not entitled to the recovery of both damages and profits but is entitled to recover either at his election, depending, of course, whether the amount of damages, proved on the accounting, exceeds the amount of profits proved on the accounting. If our contention be correct, the decree should provide only for the recovery of damages *or* of profits. Under such a form of decree, the plaintiff, on the accounting, would be entitled to prove both damages and profits and to recover the larger of the two amounts so proved. We do not contend the election should be made before the conclusion of the accounting and we are of the opinion that it is good practice for the Master to report an account of both damages and profits, if the proofs warrant such a report.

In section 1154 of *Robinson on Patents*, it is said:

"Damages, as such, were not recoverable in equity cases of infringement until the act of 1870, which conferred upon Circuit Courts the power to award them in addition to the profits. The purpose of this act was to afford the plaintiff adequate compensation for his injury in actions in equity, although the evidence on the accounting might show that the defendant had made no profits, or that the profits which he had received were insufficient to cover the whole loss that the plaintiff had sustained, and thus relieve him from the necessity of discontinuing his equitable proceedings and seeking his redress in damages at law. Construing the act in this spirit, the courts have held that wherever the plaintiff has suffered an injury by the infringement

greater than the amount of profits made by the defendant, whether because the defendant has made no profits or less than a fair profit through his unskilfulness or unwise conduct of his business, or because the wrongs inflicted on the plaintiff lie outside the scope of the mere loss of profits on the patented invention, the plaintiff is entitled to recover *in excess of profits such a sum in damages as, taken with the profits, will give him complete compensation for the injury.*"

The foregoing can be interpreted only as meaning that if the damages exceed the profits, the plaintiff is entitled to recover the full amount of damages suffered.

In the case of *Westinghouse et al. v. New York Air Brake Co. et al.*, 131 Fed., 607, it is said:

"The rule is clear that the profits which the complainant might have gained by supplying such demand are recoverable as damages which it suffered thereby. It is also clear that, if such sum exceeds the profits which the defendants gained, such profits can be enlarged until they equal the complainant's losses, *but that the two amounts cannot be added together and charged up to the defendants.*"

In *Child v. Boston & Fairhaven Iron Works*, 19 Fed., 258, it is said:

"If the plaintiff had found that his damages exceeded the defendant's profits, he might have had the larger sum assessed. *Birdsall v. Coolidge*, 93 U. S., 64."

In *Simpson v. Davis*, 22 Fed., 444, it is said:

"The fourth exception raises the question whether the plaintiffs can, by virtue of section 4919, Rev. St., recover damages resulting from the defendant's infringement of their patent in addition to the profits realized by the defendant. Doubts appear to have existed in regard to the meaning of the provision in section 4919, but I understand the Supreme Court in *Birdsall v. Coolidge*, 93 U. S., 64, to hold the effect of the statute to be this: that when it appears, in a case in equity, that the defendant's profits, derived from the use of the plaintiff's invention, do not amount to so much as the plaintiff's damages arising from the infringement, the court may add to the amount of the defendant's profits, a sum *sufficient to make the amount awarded by the decree equal to the plaintiff's damages*. So the decision referred to is understood in *Child v. Boston and Fairhaven Iron Works*, 19 Fed. Rep., 258.

"Under this construction of the statute the plaintiffs, upon the proofs in this case, may have added to the defendants' profits the sum of \$151.50, making the recovery \$303., which is the amount of the plaintiffs' damages as shown by the proofs."

In *Tilghman v. Proctor*, 125 U. S., 148, it is said:

"The rule in equity of requiring an infringer to account for the gains and profits which he has made from the use of a patented invention, instead of limiting the recovery to the amount of royalties paid to the patentee by third persons, has been constantly upheld under the provision of the patent act of 1870, embodied in the Revised Statutes, which, beside reenacting the grant of general equity jurisdiction in patent cases, further enacts that 'upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to

recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction, and the court shall have the same powers to increase the same in its discretion that are given by this act to increase the damages found by verdicts in actions upon the case'; and thus expressly affirms the defendant's liability to account for profits, as well as authorizes the court sitting in equity to award and treble any damages that the plaintiff has sustained *in excess* of the defendant's profits. Act of July 8, 1870, c. 230, Sec. 16, Stat. 206; Rev. Stat., Sec. 4921; *Birdsall v. Coolidge*, 93 U. S., 64, 69; *Marsh v. Seymour*, 97 U. S., 348; *Root v. Railway Co.*, above cited; *Manufacturing Co. v. Cowing*, 105 U. S., 253; *Garretson v. Clark*, 111 U. S., 120; *Black v. Thorne*, 111 U. S., 122; *Birdsall v. Shaliol*, 121 U. D., 485, 488; *Thomson v. Wooster*, 114 U. S., 104."

In the foregoing quotation, it will be noted that the plaintiff is entitled to recover only the damages *in excess* of the defendant's profits which can only mean, in dollars and cents, that the plaintiff is entitled to recover his full damages and, if he recovers profits, the amount thereof must be subtracted from the amount of the damages and the excess only allowed as damages. Any other construction of the statute would permit a plaintiff, in an action at law, to recover only damages and, in a suit in equity, to recover both the total amount of damages suffered and the total amount of profits received by the defendant. The purpose of the act of 1870 was obviously not to bring about any such

situation. Its purpose, as stated by Robinson, was simply "to afford the plaintiff adequate compensation for "his injury in actions in equity, although the evidence "on the accounting might show that the defendant had "made no profits, or that the profits which he had re- "ceived were insufficient to cover the whole loss that "the plaintiff had sustained . . . ."

In view of the foregoing, we submit that it was error for the lower court to award plaintiff *both* damages and profits.

For the convenience of the Court we annex hereto a copy of Judge Van Fleet's decision herein.

Respectfully submitted.

WILLIAM K. WHITE,  
Solicitor and Counsel for Defendant-Appellant.

*In the District Court of the United States, Northern  
District of California, Second Division.*

Patrick F. Dundon, Complainant, vs. L. A. Pedersen,  
Defendant.—No. 15,327.—In Equity.

FRANCIS M. WRIGHT, for Complainant.  
MILLER & WHITE, for Defendant.

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VAN FLEET, District Judge:

This is a bill to enjoin the infringement of a patent—No. 653,503—issued to plaintiff on July 10, 1900, covering “Doors for Digesters,”—a steam-tight door for use on retorts in canneries and other establishments where the processing of the product is by cooking with steam, the successful operation of which requires the introduction of steam of considerable pressure. To meet the requirements of the process the door of the retort is required to be large enough to enable the cans or other containers to be readily and quickly placed in and removed from the retort; it must be heavy to withstand the pressure of the steam; be capable of being opened and closed quickly; and to work efficiently it must be made absolutely steam-tight. The device of the patent is designed to meet these necessities, and, briefly described, is constructed substantially as follows: The door is not itself hinged to its frame

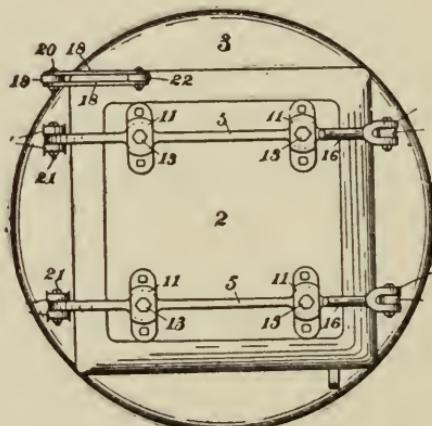
but is swung on two bars called pressure bars, which pass horizontally through housings secured to its outer surface or face, and these bars form the hinges for the door, being hinged at one end to the door-frame in such manner that when the door is swung to it closes squarely in its seat, the other end of each bar being engaged and secured by a cam connected with a link hinged to the opposite side of the frame. When closed the door bears against a gasket of suitable material set in a channel in the inner face of the frame, and is pressed firmly and evenly against the gasket by means of four screws passing through the housings and pressure bars and applied to its outer surface in such manner that when the pressure of the screws is applied the door fits at all points tightly on the gasket and thus prevents the escape of steam. The housings necessarily fit loosely upon the pressure bars to permit the door to respond to the pressure of the screws, and this looseness having a natural tendency to allow a play of the door upon the bars detrimental to its ready and perfect operation in closing, is avoided or taken up by employing what is designated as "radius links." This element and its function is thus described in the patent:

"The housings 11, as will be seen, permit some play of the bars 5, and the door 2 is not held rigidly thereby. To prevent lost or undesirable motion of this kind, I provide the radius-links 18, attached to the lug 19 on the door-frame and lug 22 on the door, the fixed pivot 20 being coaxial with the pivots 21 of the bars 5. The cams 10 are

made with more or less eccentricity, as the amount of pressure required, and when set for closing, as in Fig. II, the extreme of the eccentric passes the point of impingement, so the cam is locked or held against accidental release. In this manner it will be seen that the tendency of the door 2 to turn in its flat plane about the pivots 21 is resisted by the links 18, thus producing the effect of closely-fitting hinges and a true and steady movement of the door in opening and closing."

It is in this last-described feature that the novelty of the combination is disclosed, all the other elements being found in former patent issued to plaintiff in 1890. The subjoined drawing is a correct portrayal of the device.

DUNDON'S DEVICE



Defendant having need of retort doors for use in his fish-cannery in Alaska, purchased a number from plaintiff made in accordance with the patent as above-described and has been using them therein; but finding that he required an additional number, determined to construct them for himself. He accordingly procured castings to be made in San Francisco of the different parts, shipped them to his cannery and there assembled them. The doors thus built differ structurally from that of plaintiff in these particulars only: The pressure bars while attached to the door by housings in the same manner do not constitute hinges for the door, it being hinged independently to the frame by ordinary hinges loosely pivoted to admit of the door swinging flatly and evenly into its seat, and the door being closed the pressure bars are secured to the frame at both ends by appropriate fastenings. In other respects than serving as hinges these bars perform the same functions as in plaintiff's device, the pressure being exerted through screws passing through the housings and bars and pressing the door firmly upon the gasket. This loose hinging allowing, as in plaintiff's device, a play or sagging of the door interfering with its ready closing and adjustment in its seat, the defendant, to overcome that tendency, employs what he terms a "tie-rod," being a single bar or rod forming a tie or link pivoted to the door and frame in a precisely similar manner and in the same relative position, and performing exactly the same function as the so-called "radius-

links" of plaintiff's device. In all other respects the defendant's device is the duplicate of that of plaintiff. It is the use of this structure, and particularly the element called a "tie-rod," which it is claimed constitutes an infringement of plaintiff's patent, and whether it does or not is the one question presented, since non-infringement is the sole defense; and this defense is rested upon plaintiff's evidence, no testimony being taken on behalf of the defendant.

The question is made to turn upon the construction of claim 3 of the patent, that being the claim charged to have been infringed. The claim is in these words:

"3. In a hermetically-closing door, pressing-bars to force the door upon its seat, bearing at four or more points thereon, forming also hinges for the door, and in combination therewith the radius-links 18 pivoted in the same axial line as the pressing-bars and holding the door in adjustment thereon, substantially as specified."

That defendant's device constitutes an infringement of this claim is, I think, obvious unless the differences in structure above-noted can be held to be elemental and such as to change its co-operative or unitary action from that of the combination of the patent. Defendant's contention is that these differences are material and that its device cannot be held to infringe without ignoring certain limitations in the language of the claim which it is said constitute substantial features of plaintiff's invention, and which the Court is therefore

not at liberty to disregard. The first of these it is claimed is found in the words, "forming also hinges for the door," in describing the use of the pressure bars. It is said that this language expresses a functional limitation which restricts the combination to one in which the pressing-bars not only perform the function of pressure-bars but also the additional function of hinges for the door.

Is the difference in function between the two devices in this respect so material as to avoid infringement under the rule invoked? As indicated above, the whole element of novelty in plaintiff's combination is the means of taking up or avoiding the lost motion incident to the loose manner required in hanging the door where pressure-bars are employed. All other elements of the combination are old and covered by plaintiff's prior patent. Is the substitution of a patently equivalent means to perform one of the functions, and that a subsidiary one, of an old element of the combination, which works no essential change in the unitary result,—for that is obviously all the defendant's change involves,—sufficient to defeat plaintiff's right to protection of that which is new and valuable in his invention? It seems to me that such a result would be subordinating substance to mere form, and I do not think the claim is to be given a construction so narrow. It is not an instance, to my mind, where form partakes of the substance, but the case it seems to me falls within the very salutary principle announced in *Wi-*

*nans v. Denmead*, 56 U. S. (15 How.), 329, 342, where it is said:

“Where form and substance are inseparable, it is enough to look at the form only. Where they are separable; where the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the substance of the invention—for that which entitles the inventor to his patent and which the patent was designed to secure; where that is found there is an infringement; and it is not a defense that it is embodied in a form not described and in terms claimed by the patentee.”

It is next contended that claim 3 restricts the combination to one in which “more than one link or tie-rod is used to keep the door in adjustment”; and it is said: “It will be noted that the word ‘links’ is in the “plural, thus calling for at least two links or tie-rods. “It is not contended that defendant uses more than one “tie-rod in his device to keep the door from sagging. “It is obvious therefore that the defendant has dis-“pensed with one of the elements of claim 3 and has “substituted nothing in its place. For this reason the “defendant’s device does not infringe.” But this contention has even less merit than the first, for it is quite obvious that it is based upon a clear misapprehension of the construction of plaintiff’s combination as contemplated and described in the patent. It, I think, sufficiently appears from the specifications, but very clearly from the drawings attached to the patent

(which may be looked to in case of doubt; *Walker on Patents*, section 182), that this feature of the device which is given a plural designation is but in fact a single element. It is doubtless given its plural name by reason of the fact that it is composed of two parallel pieces of metal of uniform length, both pivoted to the same lug at each end and forming but one link or stay, —being thus constructed, very likely, for additional strength. It is no less a single element as disclosed in plaintiff's combination than the "tie-rod" of defendant's device, which, as stated, is made from a single rod or bar, and like the latter is pivoted to the door and frame in the same manner.

It is further said of this element that it is given a functional limitation in the claim which distinguishes it from the office of the tie-rod of defendant's device. This is based upon the language, "pivoted in the same axial line as the pressing-bars and holding the door in adjustment thereon." And defendant says:

"According to this limitation the links 18 must both be pivoted in the same axial line in which the pressing-bars are pivoted. In the defendant's device, the pressing-bars are not pivoted at all and are not connected to the retort wall in the same axial line in which the single tie-rod is pivoted. It will also be noted that the words 'holding the door in adjustment thereon' are a functional limitation and restrict the combination to one in which two or more links or tie-rods hold the door in adjustment on the pressing-bars. In defendant's device, the door is not supported by the pressing-bars, but by the hinges. Therefore, the single tie-rod

used by defendant cannot hold the door in adjustment on the pressing-bars, which are, in fact, supported by the door. Such tie-rod or link merely prevents the door from sagging upon its hinges, thus keeping it in adjustment relative to the hinges and not relative to the pressing-bars."

These criticisms are largely answered by what has already been said. It is quite true that defendant's tie-rod is not pivoted in the same axial line with the pressing-bars, because the latter in his device do not, as we have seen, form hinges. But the rod or link is pivoted in an axial line with the hinges which defendant has substituted for the pressure-bars to perform that office; and while, as defendant says, his tie-rod cannot, for obvious reasons, hold the door in adjustment on the bars, it does hold it in adjustment on the substitute hinges, and, as heretofore shown, subserves the same purpose in that relation as the radius-links of plaintiff.

These considerations are sufficient, I think, to show that the differences in construction of the device of the defendant are not such as to avoid infringement of plaintiff's patent. Plaintiff is accordingly entitled to a decree as prayed.

No. 2462

IN THE

United States Circuit Court of Appeals  
For the Ninth Circuit

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L. A. PEDERSEN,

*Defendant and Appellant,*

vs.

PATRICK F. DUNDON,

*Plaintiff and Appellee.*

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**BRIEF FOR APPELLEE.**

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FRANCIS M. WRIGHT,

*Solicitor and Counsel for Appellee.*

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Filed this ..... day of November, 1914.

FRANK D. MONCKTON, Clerk

By ..... Deputy Clerk.

FILED

NOV 10 1914

F. D. Monckton,

Our contention is the opposite.

To be more specific, appellant contends that Dun-don's language in his specification shows his intention to limit his invention in claim 3 to the particular form in which the pressing bars form also hinges for the door.

We contend that it does not show this.

Let us critically examine the specification.

The patentee begins by stating the art to which the invention relates, namely, doors for hermetically sealing retorts, digesters or other vessels that sustain internal pressure, and to certain improvements in devices for hinging, closing and securely sealing such doors, and he specially states that the invention is an improvement on an invention described in Letters Patent No. 418,867, granted to him almost ten years earlier.

By thus, in the first part of his specification, referring to his earlier patent, he disclaims as part of his present invention anything that was shown in said earlier patent. It is therefore of the greatest importance to examine carefully this earlier patent, for, obviously, any construction found in said earlier patent could not possibly be claimed in the later patent, and, by expressly calling attention to the earlier patent, and stating that the present invention is an improvement on said earlier patent, the patentee disclaims as part of his present invention any feature which is found to exist in said earlier patent.

Now in said earlier patent of 1890 we find that the door D, instead of being at the side of the digester, as in the present patent, is at the bottom of the digester, and it is held in place by a curved arm or bar E, pivoted at F, which arm E forms a pressing bar, pressure being applied to the door D by means of a screw L screwed through a hole in the arm or bar E. A link H is hinged to the body of the digester, as shown at I, which link H passes through the forked outer end of the bar E, and an eccentric or cam J bears against said outer end and presses the screw against the door of the digester.

Now, upon comparing the bar E, link H and cam J of the 1890 patent with the bar 5, link 14 and cam 10 of the present patent we find that they are practically the same. The only difference is that the pressing bar E in the 1890 patent has only one screw through it, whereas the pressing bar 5 of the 1900 patent has two screws through it. But, so far as the pressing bar serving as a hinge is concerned, the two patents show precisely the same construction. The pressing bar E of the 1890 patent serves as a hinge in precisely the same manner as the pressing bar 5 of the 1900 patent serves as a hinge.

It is evident, therefore, that Mr. Dundon in his patent of 1900, by expressly calling attention to the patent of 1890, and by stating that the invention of 1900 was an improvement upon said patent, *disclaimed* the pressing bar serving as a hinge as

being part of his later invention, since the constructions in the two patents are precisely identical in this respect.

Obviously, then, in order to negative such disclaimer it would be at least necessary that he should positively assert in some other part of the specification of the patent sued on that to make the pressing bars serve as hinges *was* a part of his later invention. While there is certainly language in the specification, which, if carelessly read, might be construed to signify that Mr. Dundon was making a claim for this feature, a careful examination shows that such was not the case.

To continue the examination of the specification, we find that the next two paragraphs are in the wrong order. In the paragraph beginning on line 22 of page 1 he next goes on to say of what the invention consists, and in the paragraph beginning on line 35 what are the objects of the invention. Undoubtedly the proper order is first to state what are the objects of his invention and then to state how he achieves these objects. It will facilitate the inquiry if we take first the statement of the objects, as contained in the paragraph beginning line 35.

It will be observed that the patentee says that one object of his invention is to utilize the bearing bars as hinges.

Counsel for appellant contends that this means that Mr. Dundon claims as his *present* invention the utilization of the bearing bars as hinges.

But there is quite a difference between the two following statements:

(1) My invention consists in utilizing the bearing bars as hinges.

(2) The object of my invention is to utilize the bearing bars as hinges.

The first is a statement of the *invention*. The second is a statement of the *object* of the invention.

The first is a statement of the newly discovered *means* for attaining an end. The second is a statement of an *end* to be attained, without stating what are the means for attaining that end.

If the patentee had merely said: "My invention consists in utilizing the bearing bars as hinges", then he would have been claiming the means to an end, the means being the utilization of the bearing bars as hinges, and the end being to expedite the opening and closing of the door.

But he does not say this. He says that: The object of the invention is to attain a certain end, namely, to utilize the bearing bars as hinges. How he achieves this result is explained in the previous paragraph.

But before we consider the statement of how he accomplishes this object, it may first be desirable to explain how the difficulty arises necessitating

the exercise of inventive skill to find means for accomplishing the object. In other words, seeing that Mr. Dundon had already, in his patent of 1890, shown a bearing bar acting as a hinge upon which the door swings, and serving with the screw to press said door to its seat, why should he now say that one *object* of the invention is to utilize the bearing bar as a hinge on which the door may swing. The reason is to be found in the difference in the size, position and pressure to which it is subjected, of the 1900 door as compared with the 1890 door.

The door of the 1890 patent dropped downwards and was used for discharging the contents of digesters used for rendering lard, tallow and other like matters. These being discharged in liquid form, the opening through which they were discharged needed to be only a comparatively small one, and consequently the door for closing said opening was also small. Consequently only a single pressing bar was needed, and the pressure exerted by a single screw through the pressing bar at the center of the door was sufficient to tightly close the door.

The digester door which is the subject of the present patent is of a different character. These digesters are used for cooking canned salmon and other canned goods by means of steam, defendant's digesters having been used for cooking canned salmon. The doors of these digesters or retorts

are quite large to enable the cans to be quickly placed in and removed from the retort; they are heavy to withstand the pressure of the steam; they must be capable of being opened and closed quickly; and at the same time they must be absolutely steam-tight.

The simple construction shown in the earlier patent of 1890, in which there is a single pressing bar forming also a hinge for the door and a single screw through said bar, is no longer sufficient.

The single bar of the 1890 patent would no longer give celerity of action in opening and closing the door, would no longer prevent leakage, and, unless special means were provided, the patentee could no longer utilize the bearing bars as hinges on which the door could swing, but must adopt another construction.

Therefore, the patentee seeks to devise means whereby these ends can be attained with *any* door, and not alone a small, horizontal, downwardly dropping door such as shown in the 1890 patent.

The patentee then, in the paragraph, lines 21-32 of page 1, states in general terms of which the present invention consists. The improvements are in three respects, as follows:

(1) "Two or more bars that span the door, " bearing usually at four points thereon, so selected "as to equalize the pressure around the sealed " joints and utilize the full strength of the door " itself in resisting the compressing strain."

(2) "The manner of hinging the doors by  
"means of the bearing bars and a compensating  
"link pivoted coincident therewith."

(3) "Other structural devices which will be  
"particularly pointed out and explained by the  
"aid of the drawings herewith and forming a part  
"of this specification."

We do not find, in this statement of the improvements made by the patentee, any language from which it can be inferred that the patentee intended to claim the use of the bearing bars as hinges. What he really intended to claim was the new feature, the compensating link or radius link used with a door having bearing or pressing bars and of such construction that the radius link is necessary or desirable.

There is not a single part of the specification which really implies that Mr. Dundon, in his later patent, intended to claim the use of the bearing bars as hinges. In pages 3 and 4 of appellant's brief are found extracts from the specification of the patent in suit, in which extracts the parts supposed to imply that Mr. Dundon claimed the use of bearing bars as hinges are printed in italics. The first language thus italicized is the word "hinging". But is not a radius link an improvement in "hinging, closing and securely sealing such doors"? It will be observed also that in the paragraph here quoted appellant omits the reference expressly made by Mr. Dundon to his earlier patent

disclosing the use of bearing bars as hinges, which reference is an implied disclaimer that such use is a part of his present invention.

The next language italicized is in the second paragraph after the word "also". If one were to pay attention only to the part italicized, this part would be a bald statement that the invention "consists in the manner of hinging the doors by means of the bearing bars". But this is not the statement. The statement is that it "consists in the manner of hinging the doors by means of the bearing bars *and the compensating link* pivoted coincident therewith". If the hinging of the doors by means of the bearing bars alone were claimed to be a part of the invention, then the next words would have begun "and *in* a compensating link" just as in the words used a little later "and *in* other structural devices".

The third paragraph quoted, and the whole of which is italicized, simply states the *object* of the invention and not the invention itself and has already been discussed.

The next language italicized is merely a general statement of the nature of this class of doors, and is not an assertion that a particular contrivance, to use the bearing bars as hinges, is the means for attaining the object spoken of.

The contention that Mr. Dundon in the patent sued upon claimed the use of the bearing bars as

hinges has thus, we think, been effectually disposed of.

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**WHAT IS THE UNITARY IDEA EMBODIED IN CLAIM 3  
SUED ON?**

Appellant in page 5 of his brief states that "the combination of claim 3 must be considered as a unit distinct from its parts". With this statement we entirely agree. Every claim properly drawn is a "unit". What is meant by a "unit"? Does it not mean that the claim expresses the embodiment of a single original idea, a single inventive thought? If it does not mean that, it means nothing. If a person uses this original idea, this inventive thought, without the consent of the inventor, he infringes. It is, therefore, very important to accurately determine what is the single original idea, the single inventive thought, embodied in the combination of claim 3.

If we examine this claim we find therein a pressing bar forming also a hinge for the door, which is old, and radius links, which are new. Pressing bars bearing at four or more points thereon are also old as a matter of fact, although it does not appear from the record, but whether this feature is old or not is immaterial, since appellant also uses this feature. It is evident, therefore, that the radius link forms the nucleus of the single inventive thought embodied in the combination of this claim 3. It is therefore important to obtain an

exact understanding of the reason for this radius link.

### Why is the radius link necessary?

It will be seen by reference to figure 3 of the patent in suit that the housings 11 which are rigidly secured by screws to the door 2 fit loosely over the pressing bars 5. Indeed, there must be this loose fit or lost motion to allow the screws to operate and transmit the pressure from the bars to the door at four different points thereon. There is, therefore, some play or looseness between the door and the bars. The door, not being directly hinged to the digester, and being supported loosely upon the bars, tends to sag to one side. When closed, the door bears against a gasket of suitable material set in a channel in the inner face of the frame of the retort or digester. But, if the door is loosely supported by the bars, it would not fit squarely and properly against this gasket, but would have to be pushed into place by a workman, and held there while the screws were being screwed up or the cams were being applied. This looseness the patentee remedies by the employment of what is termed in one place a compensating link and in another radius links. The compensating or radius link is a link, and not a hinge, because it is pivoted not only to the door frame but also the door, and it is called a radius link because it is pivoted to the door frame in vertical alignment with the hinges for the pressing bars, so that the part of the door

connected to one end of the link moves about the other end in a circle of the same radius as that about the hinges. This radius link prevents the door from longitudinally shifting on the pressing bars, although it does not prevent the door from moving to or from the pressing bars, such movement being required for the operation of the screws.

This radius link or compensating link, so far as known, is entirely new in this connection or a similar one. The tie rod E in the patent to Unfried is entirely different from this radius link. It is nothing more than an ordinary brace of a gate. If, indeed, the wire marked J in the Unfried patent had been attached at its lower end to Unfried's gate, then it would more nearly resemble applicant's radius link, for it would have been pivotally attached at one end to the gate and at the other end to the gate frame. But the tie rod E is rigidly attached at both ends to the gate, and is nothing more than a different form of the well known diagonal brace of a farm gate.

Now in claiming this radius link it was necessary of course for the patentee to claim also such other elements as are necessary to make the radius link of any value. A claim for this single element itself, such as "radius links" would be meaningless. It is only when the new construction is used in combination with an old construction that any advantageous result is obtained. For this reason

it was necessary to explain in the claim *with what kind* of old construction the new construction can be used in combination and have any value. But while the patentee is bound by limitations (except obvious equivalents) of his new construction expressed in his claim, he is not strictly bound by limitations of the old construction as so expressed, but is entitled to protection of the invention used on any equivalent old construction.

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#### **DOES DEFENDANT USE AN EQUIVALENT CONSTRUCTION?**

The question now arises: What would be an equivalent old construction? The answer is that an equivalent old construction is one that could be used in the combination without changing the character of the unitary original conception embodied in the combination.

For instance, a weight is sometimes the equivalent of a spring and sometimes it is not. If the function of the spring is merely to produce a constantly acting force, and the production of a constantly acting force is the only function of the spring which enters into the unitary idea of the combination, then the weight is its equivalent, because the weight will do the same thing in the combination. But if, in addition to producing a constantly acting force, a spring is used to give an oscillatory movement, and this oscillatory movement forms part of the unitary idea of the com-

bination, then a weight, which does not give this oscillatory movement, is not the equivalent of a spring.

Now comparing defendant's structure with the combination of the third claim, we find that both structures have the radius link. Both structures have pressing bars to force the door upon its seat, bearing at four or more points thereon. Both *must* have such a construction that, while the door can swing in general in a circular movement to or from the retort, it may also be capable of a slight linear movement to or from said retort. This linear movement is absolutely necessary to allow the screws to act, so as to press the door tightly against all points of the seat on the door frame. In Mr. Dundon's device this slight linear movement, as well as the circular movement, is obtained by making the pressing bars which serve as hinges pass loosely through the housings which are secured to the door. In defendant's device the pressing bars do not serve as hinges, and therefore it is absolutely necessary that the hinges should be loose on the hinge pins to permit of the slight linear movement of the door to or from the retort which is necessary to permit the screws being applied at four or more points thereon. A little consideration will show that it is quite impossible for these screws to press the door at four or more points so that the door fits tightly against its seat in defendant's construction unless some play or looseness is allowed in the hinges. Moreover, the fact

that defendant had to adopt a radius link proves that this looseness of the hinges existed, and in fact it is a physical impossibility that it should not exist.

What we contend then is that, by making the door hinges loose upon the hinge pins, so as to permit of a direct linear movement of the door to and from the retort, defendant did not avoid infringement, for he adopted the same unitary idea which was the invention of applicant.

To make the pressing bars form also the hinges of the door was *not* a part of this idea, having been invented and patented ten years earlier. *Any* construction that would permit of the door having a direct linear movement to and from the door frame would be the equivalent, *in this combination*, of making the pressing bars serve as hinges, because, in an embodiment of the unitary idea in the combination, they both serve the same purpose.

But since it is clear that defendant used a construction which permitted the door to have direct linear movement, as well as a circular movement, to and from the door frame, he used the equivalent feature in question and therefore did not avoid infringement.

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#### APPELLANT'S CITATIONS.

As regards the reference on pages 6, 8, 9 of appellant's brief to functional limitations, we have never contended that a functional limitation is to

be treated otherwise than a structural limitation. The rule with functional limitations, as with structural limitations, is that only that part of the function which enters into the unitary idea embodied in the combination cannot be ignored, and whatever substitute performs the same function *in the combination* is a mechanical equivalent. So where it appears that the function was intended to be made an essential element of the claim, it cannot be disregarded. But where such does not appear to have been the case, any function which does not relate to the inventive thought embodied in the claim may be ignored.

The words "forming also hinges for the door" define for what kind of a door the radius link is necessary, namely, for a door having both a circular, and a direct linear, movement, to and from the door frame. The word "hinges" shows that it has a circular movement and the words (pressing bars) "forming also" show that it is capable of a direct linear movement, because they show that the door is *not directly* hinged to the door frame, but is hinged by means of the pressing bars on which the door is *loosely* supported.

The use of these words then, and the only use, *in this combination*, being to express a very essential condition of the combination, viz : that the door should be capable of a direct linear, as well as a circular, movement, any construction in which the same condition is found is a mechanical equiva-

lent, even though it does not also give the additional advantage expressed by said words, which was disclosed and patented long before, and is not material to the present invention.

Referring to the case of O. H. Javell Filter Co. v. Jackson, cited on pages 7, 8, of appellant's brief, attention is requested to the words "that are not evasions" in line 4, page 8. We contend that defendant's construction is a very obvious evasion of complainant's improvement.

Comparing the present claim with the claim in Computing Scale Co. v. Keystone Store Service Co. (page 9, appellant's brief) it cannot be said that the words "forming also hinges" in the present claim mean nothing in the combination. It has just been shown that they alone express a very essential condition of the combination, namely, that the door has both a circular and a direct linear movement.

Referring to the decision in American School Furniture Co. v. Sander Co. (page 13, appellant's brief) it is sufficient to say that we maintain that defendant *did* "substitute (something) equivalent thereto".

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#### RECAPITULATION.

To recapitulate the reasons why defendant's construction should be held to be the equivalent of the first limitation above referred to, namely, the use of pressing bars as hinges.

Complainant's patent of 1900 differs from his patent of 1890 in the inclusion of the radius link. This radius link was devised because it is necessary that the door should be supported on the door frame so as to be capable, not only of a circular movement like the door of a safe, but also of a slight linear movement to and from the door frame. This linear movement is necessary to enable the door to be pressed against the door frame with an absolutely steam-tight joint at all points. This steam-tight joint could not be attained with certainty with a purely circular movement. There must be, in addition, some capability, of linear movement. And it is this capability of linear movement, possessed by a large and heavy door, such as the door of a steam cooker, which requires the radius link to be used. This radius link must be pivoted at one end to the door frame in vertical alignment upon the hinges of the door, and at the other end to the door at a point between, or at least not outside of, the pressure screws, that is, to a mediate point of the door. Without this radius link, on account of the loose pivots, the upper part of the door would move inwards on the lower pivot. In that case the door would not fit accurately against the frame. The provision of this radius link insures this accurate fit and insures a steam-tight joint when the door and the frame come together.

It was old to hinge a door to a door frame and to secure thereon pressing bars so that the door

can have a slight linear movement to and from the door frame, this being shown in Dundon's earlier patent in 1890. The second requirement, the radius link, was not embodied by him at that time, because the door was comparatively small and, instead of swinging horizontally, swung vertically and therefore there was no need of this device.

When he came to apply the pressing bars of 1890 to a door of much greater size and weight and which swung horizontally instead of vertically, he discovered that his invention of 1890 was not applicable to such a door, and it was only when he devised the radius link pivoted at one end to the frame in vertical alignment with the door hinges and at the other end to a portion of the door between the pressing bars, that he made the door a success.

Now comes defendant and attempts to avoid this claim by not making the pressing bars and hinges in one piece. The idea embodied in the combination of claim 3 is not the making of the pressing bars and hinges in one piece, since that was disclosed in complainant's patent of 1890. The novel idea was the employment of a radius link. Complainant in claim 3 recites the radius link, and the pressing bars disclosed in the specification and drawing, which is evidently the preferable construction. It is the preferable construction, because it saves time in the opening and closing of the door. But this saving of time in the opening and closing of the door is not the result or function

for which the combination of the claim is intended, but is an old idea, having been disclosed in complainant's patent of 1890. Defendant, in trying to avoid infringement, gives up this advantage of saving time in the opening and closing of the door, but must still be held to infringe claim 3. The purpose of the combination of claim 3 is not to save time in the opening and closing of the door, but to insure a steam-tight fitting joint all around the door.

“The capability of fewer—uses by reason of its new connections—is a change consistent with the preservation of the identity of the patented invention, and with its wrongful appropriation by the alleged infringer.”

Robertson on Patents, Vol. 3, pp. 49-50.

In the case of Coupe et al. v. Weatherhead et al.,  
16 Fed. Rep. 673:

“The defendants at one time used a machine which closely resembles that of the plaintiffs’—in the legitimate attempt to avoid infringement of the plaintiffs’ invention, which the defendants intended to copy as far as they lawfully might, because they had failed to come to terms with the plaintiffs for a license, they now put into the trough a piece of board, supported at either end upon blocks, about one-third of the width of the trough. The operation of the machine as thus modified is known only to the defendants themselves, and Mr. Weatherhead testifies that it exerts a pressure upon the hide, how great in pounds we do not know. We understand him to say that by passing the hide through the machine several times all parts come sooner or later under the

board, and thus substantially all the stretching is done by its aid.

"Infringement of the plaintiffs' first claim is not escaped by the use of this piece of board, for, although it causes the defendants' machine to approach more nearly the old belt-stretcher, still the operation must remain to some extent at least like that of the patent. The manipulation with the table and grooves must enable the operator to use all the elements of the first claim upon two-thirds of the width of the hide each time it passes through the machine, and it depends altogether on the thickness and stability of the board whether the whole operation is or is not copied. The very presence of this removable board is evidence that the old machine is not satisfactory for the new use."

This case is even stronger than that, for in that case the change made by the infringers in the elements of the combination appreciably diminished the effectiveness of the combination in performing the function for which said elements were so combined. In the present case the change in the elements does not diminish in the least the effective performance of the function or idea which the combination of claim 3 is intended to embody, namely, to insure a steam-tight fitting joint all around the opening. It only diminishes the effective performance of an entirely different function or purpose, namely, it reduces the celerity with which the door can be opened and closed.

In regard to the distinction which appellant draws between "links" and "link", on turning to

appellee's patent, we at once see that the use of the plural for the singular in speaking of the radius link simply arose from the fact that, for convenience of construction, the patentee employed *two* links 18, the respective ends of which extended on opposite sides of the lug 19, and on opposite sides of the lug 22. No reason is given in the patent for using the two links 18 instead of one. It is evident that the two links move together like a single link or bar and perform the same function, and really constitute a single link, and on page 1, line 30 of the patent, it is termed a *link* and that therefore a single bar is a mechanical equivalent of the two bars.

"A claim for means for operating a washing machine, one element whereof is a double row of teeth or cogs upon the cylinder of shaft, is infringed by a device wherein each element is present excepting the double row of teeth or cogs, for which is substituted a single row of teeth or pins, operating in substantially the same way to produce the same result, and obviously designed to evade the wording of the claim in suit."

Benbow-Brammer Mfg. Co. v. Simpson Mfg. Co. et al., 132 F. 614.

"The substantial identity of the Walker and Birkenhead rests is not affected by the circumstance that in that of the former it is composed of one part, while that of the latter is composed of two."

Eames v. Worcester, 123 Fed. 67.

The third limitation is expressed in the words “in the same axial line as the pressing bars and holding the door in adjustment thereon”.

Since the patentee contemplated using the pressing bars also as hinges for the door, the words “in the same axial line as the pressing bars” are evidently equivalent to “in the same axial line as the hinges” the terms “pressing bars” and “hinges” being then interchangeable. Therefore the difference in terms expressed by the words “in the same axial line as the pressing bars” instead of “in the same axial line as the hinges” is simply a repetition of the former limitation, that the pressing bars are also hinges.

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#### SUMMARY.

1. Mr. Dundon has made at different times two separate and distinct improvements, viz.:

A. Making a pressing bar and hinge in one piece, covered by his patent of 1890.

B. Adding a radius link for a horizontally swinging door, having four or more pressure points, covered by claim 3 of his patent of 1900 in suit.

2. The object of making invention A was to save time in opening and closing the door.

The object of making invention B was to hold the door in adjustment on its seat.

3. Claim 3, sued on, was intended to protect invention B, not invention A, which was already protected by the 1890 patent.

4. The above-stated "holding in adjustment" was only necessary when the door was not tightly hinged to the frame.

5. Hence it was incumbent on the patentee to include in the claim the construction on account of which the door was not tightly hinged to the frame.

6. He therefore included the construction actually used.

7. But, if the cause of the evils to be overcome by the invention (the door not being tightly hinged to the door frame) is the same, and the means (the radius link) invented for overcoming the evils, are the same, the particular character of the construction producing this cause does not affect or change the identity of the invention.

8. Hence, any construction on account of which the door is not tightly hinged to the frame is the mechanical equivalent, in the claim, of the construction specified.

9. In defendant's construction the door could not be tightly hinged to the frame, for if it were,

- (a) The pressure screws could not act.
- (b) There would be no use for the radius link.

10. Hence defendant used the same idea of means for holding the door in adjustment on its seat which is covered by claim 3, and infringes.

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In regard to the second alleged error of the lower court, namely, that plaintiff is entitled to recover both damages and profits, we respectfully submit that there was no error, for the reason that the language of Section 4921 of the United States Revised Statutes is, in part, as follows:

\* \* \* "and upon a decree being rendered in any such case for an infringement the complainant shall be entitled to recover *in addition to the profits* to be accounted for by the defendant, *the damages* the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction."

Dated, San Francisco,

November 9, 1914.

Respectfully submitted,

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